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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/791,526 | 03/03/2004 | Kazuhsia Takashima | Q80128 | 3353 |
| 23373 | 7590 | 07/16/2004 | EXAMINER | |
| SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037 | | | NGUYEN, HANH N | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 2834 | |

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/791,526 | TAKASHIMA ET AL. |
| | Examiner | Art Unit |
| | Nguyen N Hanh | 2834 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3,5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. in view of Schmider

Regarding claim 1, Tanaka et al. disclose a rotating electric machine, comprising: a bowl-like housing (16 in Fig. 1) having a through hole penetrated by a shaft and having a cutout portion in a part of an opening portion; a commutator (11) fixed to the shaft; a base (14) fixed to the housing by a clamp screw (17 in Fig. 2) and having a tapped hole (Fig. 1) through which the clamp screw is inserted with a play; a brush (13) disposed in the base and rubbing against the commutator; a plate having a joint portion (Col. 3, lines 37-39) to which a lead wire led outside is welded and fixed to the base; a

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grommet (21) penetrated by the lead wire and engaged in the cutout portion of the housing. Tanaka et al. fail to show a positioning unit which positions the lead wire to be welded in the joint portion.

However, Schmider discloses a rotating electric machine with a brush base comprising a positioning unit (91,92 and 93 in Figs. 5 and 6) which positions the lead wire to be welded in the joint portion for the purpose of relieving tension from the outside of the machine.

Since Tanaka et al. and Schmider are in the same field of endeavor, the purpose disclosed by Schmider would have been recognized in the pertinent art of Tanaka et al.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Tanaka et al. by using a positioning unit which positions the lead wire to be welded in the joint portion as taught by Schmider for the purpose of relieving tension from the outside of the motor.

Regarding claim 5, Schmider also discloses a rotating electric machine wherein the lead wire includes a plurality of lead wires (two lead wires as shown in Fig. 2); the positioning unit includes a plurality of positioning units; an interval between the lead wires penetrating through the housing and an interval between the positioning units are equal for the purpose of relieving tension from the outside of the motor.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Tanaka et al. by making an interval between the lead wires penetrating through the grommet and an interval between the positioning units are equal for the purpose of relieving tension from the outside of the motor.

Regarding claim 7, Tanaka et al. also discloses a rotating electric machine further comprising: an elastic body (60 in Fig. 5); wherein the base is fixed via housing by the elastic body to the housing.

Regarding claim 8, Tanaka et al. also discloses a rotating electric machine wherein the plate is insert molded into the base by a resin material forming the base (Col. 3, lines 37-40); and the joint portion being disposed inside an outer circumferential face of the base (Fig. 2).

Regarding claim 9, Tanaka et al. also discloses a rotating electric machine wherein the rotating electric machine is a brush motor employed for an electric power steering apparatus.

Regarding claim 2, Schmider also discloses a rotating electric machine wherein the position unit is formed integrally with the base. Schmider fails to show the position unit is made of a resin material for forming the base. However, it would have been obvious at the time the invention was made to a person having an ordinary skill in the art to use a resin material for forming the base, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 3, Schmider discloses the claimed invention except for showing the positioning unit has a tapered face. It would have been an obvious matter of design choice to make the positioning unit has a tapered face, since such modification would have involved a mere change in the shape of a component. A change in shape is

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generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. in view of Schmider and further in view of Nishumura.

Regarding claim 4, Tanaka et al. and Schmider show all limitations of the claimed invention except showing the rotating electric machine wherein the lead wire has a conductor including a plurality of element wires

However, Nishumura discloses a rotating electric machine wherein the lead wire has a conductor including a plurality of element wires (Fig. 4 and Col. 1, lines 23-25) for the purpose of facilitating the extension of the lead wire to the outside of motor housing (Col. 2, lines 9-11).

Since Tanaka et al., Schmider and Nishumura are in the same field of endeavor, the purpose disclosed by Nishumura would have been recognized in the pertinent art of Tanaka et al. and Schmider.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Tanaka et al. and Schmider by using a lead wire h=as a conductor including a plurality of element wires as taught by Nishumura for the purpose of facilitating the extension of the lead wire to the outside of motor housing.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. in view of Schmider and further in view of Iwata et al.

Regarding claim 6, Tanaka et al. and Schmider show all limitations of the claimed invention except showing the rotating electric machine wherein the grommet has a

thinned portion around the outer circumference of the lead wire penetrating through the grommet on the side of the joint portion.

However, Iwata et al. discloses the rotating electric machine wherein the grommet (13 in Fig. 1) has a thinned portion (13a as described in Col. 4, lines 45-55) around the outer circumference of the lead wire penetrating through the grommet on the side of the joint portion for the purpose of coupling the grommet to the lead terminal.

Since Tanaka et al., Schmider and Iwata et al. are in the same field of endeavor, the purpose disclosed by Iwata et al. would have been recognized in the pertinent art of Tanaka et al. and Schmider.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Tanaka et al. and Schmider by using a grommet has a thinned portion around the outer circumference of the lead wire penetrating through the grommet on the side of the joint portion as taught by Iwata et al. for the purpose of coupling the grommet to the lead terminal.

Conclusion

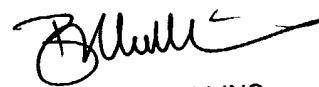
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh N Nguyen whose telephone number is (571) 272-2031. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner 's supervisor, Darren Schuberge, can be reached on (571) 272-2044. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9306 for regular communications and (703) 872-9306 for After Final
communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 308-
1782.



BURTON S. MULLINS
PRIMARY EXAMINER

HNN

July 14, 2004